

Remarks/Arguments:

Claims 21 – 36 are cancelled and new claims 37 – 50 provided herewith. New independent claims 37 and 48 include Applicant's compressible member as being part of the claimed compressible housing to further emphasize that the housing includes a member (i.e., no. 21 in FIG. 1) capable of being compressed and thus accommodating the electronic component therein (without crushing or otherwise causing damage thereto). In new dependent claim 42, this member is further defined as being a resilient pad. Support for this amending is provided in earlier claims 21 and 26, and in the Specification (see, e.g., page 8, first para.). Compressible member 21 is an extremely important part of the compressible housing (which also includes the base and cover defined earlier) because it is positioned between the base and cover and, significantly, also between the cover and the electronic component when the electronic component is positioned within the compressible housing. As such, member 21 uniquely assists to substantially prevent excessive force application on the component (14) by both the cover (27) and the compressible probes (19) because of its ability to be compressed. It provides cushioning against excessive forces from the cover, and also counters effects from additive excessive upward forces by the probes against the component's underside conductors. Applicant is also quick to point out that the claimed probes themselves are of course also resilient (compressible) to further assist in preventing excessive force application. Finally, the apparatus (and method using same) of independent claims 37 and 48 includes Applicant's unique adjustable alignment member (61) which serves as a final stop location for the base (25) of the compressible housing, to even further assist in excessive force application on the conductors 13 (which, as mentioned, can be relatively delicate solder balls). The instantly claimed invention thus utilizes three structural components, working together, to prevent excessive forces being applied onto the often delicate conductors (e.g., solder balls) of an electronic component being tested.

Dependent claims 38 – 47 and 49 and 50 include similar limitations as in the claims now cancelled and thus find full support therein.

All of the subject matter in the claims now presented are fully supported and do not, therefore, constitute the addition of new matter. Entry is urged.

The rejection under 35 USC 102 is traversed. Applicant respectfully asserts that the structure of **Barabi** (6,046,597) fails to remotely teach or suggest the claimed invention. **Barabi** does indeed describe a structure in which a “cover” 11 is attached to a body structure consisting of a “body” 17 and a plurality of “shoulder portions” (23) to retain a chip 13 therein, and also to press the chip against spring contacts 29 located within body 17. However, nowhere does **Barabi** teach or suggest excessive force prevention, nor is this structure capable of doing so in the unique manner taught by Applicant. **Barabi** simply compresses the chip between two *rigid* elements and then forces these down onto compression spring contacts which are the only force compensating elements of his structure. These, however, cannot compensate for excessive force application, nor does **Barabi** suggest the need to do so. Contrarily, such compression springs only serve to *increase* the force as normally occurs when one compresses a spring. There is no compensation in **Barabi** for such increased forces should these reach the excessive stage, as is uniquely provided in the claimed invention. Admittedly, **Barabi** also mentions use of a “pressure plate” (39), but specifically mandates that this be a *rigid* component (and thus inherently incapable of providing force compensation). **Barabi** defines this plate as being of steel, or, if not steel, of a plastic such as Ultem (*sic*) 1000. (Applicant argues that **Barabi** meant to say “*Ultem 1000*”, a well known plastic sold by the General Electric Company). Applicant cannot locate any mention of a “Ultem” plastic in the literature. Included herewith is a 3-page webpage (MatWeb) description of GE’s *Ultem 1000*. Notably, it possesses both tensile and flexural moduli in excess of 500,000 pounds per square inch (p.s.i.) and a Vicat softening point in excess of 425 degrees Fahrenheit. This material is thus extremely rigid and incapable of softening well beyond the

temperatures to which such a test apparatus would be exposed. Barabi thus only teaches or suggests using a rigid, solid member for his plate 39, and definitely not one capable of being compressed (e.g., as in the case of a resilient pad as defined in Applicant's dependent claim). Barabi thus fails to teach all of the elements of the claimed invention and fails as a proper reference under 35 USC 102. An "anticipating" reference must describe all of the elements and limitations of the claim in a single reference, and enable one of skill in the field of the invention to make and use the claimed invention. *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1378-79 (Fed. Cir. 2001); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989). Withdrawal of the rejection is respectfully urged and allowance of independent claims 37 and 48 is requested.

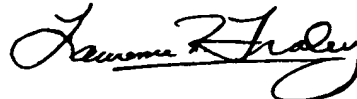
The rejection of Applicant's dependent claims under 35 USC 102 as identified in the Office Action is also deemed overcome, and withdrawal thereof is likewise urged. Moreover, these claims depend directly or indirectly from claims deemed patentable and are similarly viewed.

The rejection of previous claims 25 and 31 – 32 based on Barabi in view of Ramos (6,377,062) and Higgins (6,037,785) is also traversed. Like Applicant's aforementioned dependent claims, claims 25 and 31 – 32, now presented as claims 41 and 46 – 47, depend directly or indirectly from new independent claim 37 and thus from subject matter deemed patentable. The use of a pneumatic member such as mentioned in Ramos with the lacking structure of Barabi would still not prevent excessive force application as uniquely taught by Applicant. Additionally, the use of clamping screws as discussed by Higgins (shown especially in his Figures 3 and 8) would only exacerbate the non-compensated force application by Barabi. Nowhere do either Ramos or Higgins suggest excessive force prevention, let alone the multiple fashion of the claimed invention. There is thus no suggestion, express or inherent, for the

combination. The law is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Because the combining would only increase the likelihood of harm to the **Barabi** contacts, and because neither of these secondary documents suggests excessive force compensation, the rejection is improper. Withdrawal thereof and allowance of the respective dependent claims is urged.

The Application is deemed in condition for allowance, and such action on the part of the Examiner is respectfully urged. Should the Examiner believe, however, that minor differences may remain which, if overcome, will result in allowance of this Application and that said differences may be openly discussed in a telephone conversation, the Examiner is respectfully requested to phone the undersigned to discuss such differences and hopefully resolve same, thereby expediting prosecution of this Application.

Respectfully submitted,



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